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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/770,511	02/04/2004	Takao Kasai	4670-0102P	1770
2292 7590 12/01/2009 BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747				
EXAMINER				
KIDWELL, MICHELE M				
ART UNIT		PAPER NUMBER		
3761				
NOTIFICATION DATE		DELIVERY MODE		
12/01/2009		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

# Office Action Summary

**Application No.**

10/770,511

**Applicant(s)**

KASAI, TAKAO

**Examiner**

Michele Kidwell

**Art Unit**

3761

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 August 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1 – 4 and 10 – 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ducker et al. (US 5,938,649).

With respect to claims 1, 3 – 4 and 10 – 12, Ducker et al. (hereinafter “Ducker”) disclose a diaper (abstract) comprising a liquid impermeable back outer layer sheet and a absorber fixed on the outer layer sheet and a gather portion having a flexible elastic member formed on a predetermined position as claimed (col. 4, lines 18 – 30), wherein a water soluble skin care agent is applied on a predetermined region of a surface to be contacted with the skin of the wearer of the gather portion (col. 4, lines 31 – 55) and wherein an oily skin care agent is applied directly on the water-soluble skin care agent

as set forth in col. 5, lines 37 – 42. Ducker also discloses the use of a surfactant as set forth in col. 5, lines 44 – 46. The examiner contends that the manner in which the surfactant and agents are applied to the article is considered as product by process limitations which do not patentably distinguish the claimed invention from the prior art.

The difference between Ducker and claim 1 is the explicit teaching that the water soluble skin care agent being applied on an entirety of the surface to be contacted with the skin of a wearer of the gather portion.

It would have been obvious to one of ordinary skill in the art to provide the water soluble skin care agent being applied on an entirety of the surface to be contacted with the skin of a wearer of the gather portion since the inclusion of such would ensure that the agent is available to contact as much of the wearer as possible thereby providing added protection.

Additionally, the examiner contends that the general concept of providing the agents has been disclosed by the prior art. Therefore, the modification of the amount of the agents provided is within the level of ordinary skill in the art.

The difference between Ducker and claim 2 is the provision that the predetermined position contains a longitudinal direction end that is a waist gather.

It would have been obvious to one of ordinary skill in the art to provide the absorbent article of Ducker with a waist gather since the use of waist gathers is well known in the art to provide a more fitted article about the waist of the wearer thereby preventing undesirable leakage.

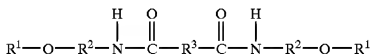
Claims 5 – 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ducker in view of Hoshino et al. (US 6,685,953) and further in view of Ptchelintsev et al. (US 5,834,513).

As to claims 5 – 9, Ducker discloses the absorbent diaper with mono-amide derivative oily skin care agent as discussed above with respect to claim 1.

Ducker further discloses a method of improving skin health using the skin care composition aforementioned (column 1, lines 12 – 28).

The difference between Ducker and claim 5 is the provision that the diamide formula is specifically as claimed.

**Hoshino** discloses a dermatologic preparation for preventing skin chaffing that can be incorporated into a carrier base material (column 7, lines 4-14) in the form of lotion or other forms (column 7, lines 37-44) that has the diamide derivative formula as shown below:



wherein R1 represents a linear or branched hydrocarbon group having 1 to 22 carbon atoms which may be substituted by one or more hydroxyl and/or alkoxy groups, R2 represents a linear or branched divalent hydrocarbon group having 1 to 12 carbon atoms, and R3 represents a linear or branched divalent hydrocarbon group having 1 to 42 carbon atoms (column 2, lines 2-14).

One would be motivated to modify the mono-amide skin care composition disposed on absorbent of Ducker with the diamide formula of Hoshino to provide a

healing skin care composition since it is known that mono-amide derivatives can be substituted for diamide derivatives for treating skin as supported by Ptchelintsev (column 3, lines 10-58) and since the references are in the same problem-solving area; amide skin treating compositions. Therefore, it would be obvious to one of ordinary skill in the art at the time the invention was made to modify the skin care composition disposed on the absorbent, thus providing a the diamide derivative with the aforementioned formula for improved skin care health.

### ***Response to Arguments***

Applicant's arguments filed August 28, 2009 have been fully considered but they are not persuasive.

In response to the applicant's argument that the references fail to disclose providing the agent on an entirety of the surface, the examiner maintains that the general knowledge of providing the claimed agent is taught by the prior art and the modification of providing the agent over an entire surface is within the level of ordinary skill in the art at least for the benefit of providing additional agent, thereby providing additional protection.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the need for auxiliary agents) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are

not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

The examiner contends that the open ended language allows for the inclusion of additional elements.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, each of the references is concerned with the same problem-solving area (i.e., a utilizing amide skin treating compositions).

#### ***Allowable Subject Matter***

Claim 13 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

#### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michele Kidwell whose telephone number is 571-272-4935. The examiner can normally be reached on Monday thru Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tatyana Zalukaeva can be reached on 571-272-1115. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Michele Kidwell/  
Primary Examiner, Art Unit 3761